

10-22-07

JFW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	10/760,091
		Filing Date	January 16, 2004
		First Named Inventor	Thomas L. CANTOR
		Art Unit	1641
		Examiner Name	C. Cheu
Total Number of Pages in This Submission	12	Attorney Docket Number	532212000624

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form (1 page plus duplicate) <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement (5 pages) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): PTO/SB/08a/b Form (2 pages plus duplicate) References (37) Return Receipt Postcard
<b>Remarks</b>  CUSTOMER NO. 25225		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Peng Chen		
Date	October 19, 2007	Reg. No.	43,543

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814073115 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 19, 2007

Signature: (Diane Blevins)

sd-397697



PTO/SB/17 (02-07)

Approved for use through 02/28/2007. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

<b>Effective on 12/08/2004.</b> <b>Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</b>		<b>Complete if Known</b>	
<b>FEE TRANSMITTAL</b> <b>For FY 2007</b>		Application Number	10/760,091
		Filing Date	January 16, 2004
		First Named Inventor	Thomas L. CANTOR
		Examiner Name	C. Cheu
		Art Unit	1641
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Attorney Docket No.	532212000624
<b>TOTAL AMOUNT OF PAYMENT</b>		<b>(\$)</b>	<b>180.00</b>

<b>METHOD OF PAYMENT</b> (check all that apply)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card
<input type="checkbox"/> Money Order	<input type="checkbox"/> None
<input type="checkbox"/> Other (please identify): _____	
<input checked="" type="checkbox"/> Deposit Account	Deposit Account Number: <b>03-1952</b> Deposit Account Name: <b>Morrison &amp; Foerster LLP</b>
For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)	
<input checked="" type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee
<input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17	<input checked="" type="checkbox"/> Credit any overpayments

<b>FEE CALCULATION</b>							
<b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>							
	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		
		<b>Small Entity</b>		<b>Small Entity</b>		<b>Small Entity</b>	
<b>Application Type</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fees Paid (\$)</b>
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
<b>2. EXCESS CLAIM FEES</b>							
						<b>Small Entity</b>	
<b>Fee Description</b>						<b>Fee (\$)</b>	<b>Fee (\$)</b>
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
<b>Total Claims</b>		<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>	<b>Multiple Dependent Claims</b>		
_____ - 20 = _____		x _____	= _____		<b>Fee (\$)</b>		<b>Fee Paid (\$)</b>
HP = highest number of total claims paid for, if greater than 20.							
<b>Indep. Claims</b>		<b>Extra Claims</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>			
_____ - 3 = _____		x _____	= _____				
HP = highest number of independent claims paid for, if greater than 3.							
<b>3. APPLICATION SIZE FEE</b>							
If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>			
_____ - 100 = _____	/50	_____ (round up to a whole number) x _____	= _____				
<b>4. OTHER FEE(S)</b>							
Non-English Specification, \$130 fee (no small entity discount)						<b>Fees Paid (\$)</b>	
Other (e.g., late filing surcharge): <b>1806 Submission of an Information Disclosure Statement</b>						<b>180.00</b>	

<b>SUBMITTED BY</b>			
Signature		Registration No. (Attorney/Agent)	43,543
Name (Print/Type)	Peng Chen	Telephone	(858) 720-5117
		Date	October 19, 2007

sd-397696

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814073115 US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

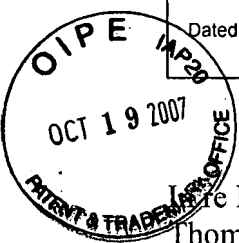
Dated: October 19, 2007

Signature: 

(Diane Blevins)

Patent

Docket No. 532212000624



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re Patent Application of:  
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING  
AND MONITORING PARATHYROID  
AND BONE STATUS RELATED  
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

**SUPPLEMENTAL INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. § 1.97 & 1.98**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicants submit for consideration in the above-identified application the documents listed on the attached Form PTO/SB/08a/b. Copies of the documents are also submitted herewith. The Examiner is requested to consider and make these documents of record.

The document numbers 1-19 listed on the attached Form PTO/SB/08a/b are from Patent Interference No. 105,575 (MPT), between 10/641,780 and U.S. Patent No. 6,838,264. Application No. 10/641,780 is related to the present application. In document number 19, Zahradnik List of Motions, Zahradnik alleges that the allowed claims of application number 10/641,780 are invalid and unenforceable. Document number 37 was cited in document number 19.

10/23/2007 SFELEKE1 00000011 031952 10760091

01 FC:1806 180.00 DA

sd-394062

Applicants point out that a prior art reference, Wood, Ann. Clin. Biochem., 29:11-21 (1992), was submitted as part of the "Opposition Documents against JP Patent No. 3457004, Opposition No. 2003-73801, dated December 29, 2003," as document No. 66 submitted in the September 29, 2006 Supplemental IDS in connection with the present application. Applicants stated in the September 29, 2006 Supplemental IDS that "Document numbers 66-70, and 581 are from an invalidation proceeding against JP Patent No. 3457004." Applicants also stated that "Scantibodies is opposing the '790 patent's corresponding patent in Europe, EP Patent No. 0 783 522 in the EPO, and commenced an invalidation proceeding against the '790 patent's corresponding patent in Japan, JP Patent No. 3457004, in the JPO. The JPO has invalidated JP Patent No. 3457004." The Examiner of the present application considered document No. 66 submitted in the September 29, 2006 Supplemental IDS and made it of record in the present application, initialed on October 12, 2006, and returned with the Office Action mailed on October 23, 2006.

Applicants point out that the Final Office Action from the reexamination of U.S. Patent No. 6,689,566 (the '566 patent) was submitted as document No. 721 in the September 29, 2006 Supplemental IDS in connection with the present application. Applicants also pointed out specific documents from the reexamination of the '566 patent and stated in the September 29, 2006 Supplemental IDS that "The U.S. PTO issued a Final Office Action on September 21, 2006." The Examiner of the present application considered document No. 721 submitted in the September 29, 2006 Supplemental IDS and made it of record in the present application, initialed on October 12, 2006, and returned with the Office Action mailed on October 23, 2006.

Document number 33 was submitted by the Applicants in an EP Opposition proceeding against EP Patent No. 0 783 522. The following documents were cited in document number 33:

- Declaration of Hans H. Linden (D22) (cited herewith as document number 34 on the attached Form PTO/SB/08a/b).
- Concession Report for 1994 of the Dutch Mailing Service KPN (D23) (cited herewith as document number 35 on the attached Form PTO/SB/08a/b).

- TAM et al., PNAS USA (1988) 85(15):5409-5413 (D24) (cited herewith as document number 31 on the attached Form PTO/SB/08a/b).
- ADERMANN et al., "Aspects of Synthesis and Analysis of Multiple Antigen Peptides", Innovations and Perspectives in Solid Phase Synthesis, Epton (ed.), Mayflower World Wide, Birmingham: 429-432 (D25)(previously submitted).
- WO 91/06564 (D26a) (previously submitted).
- US Patent No. 5,744,444 (D26b) (previously submitted).
- TAKANO et al., Acta Endocrinologica (1988) 118:551-558 (D27) (cited herewith as document number 30 on the attached Form PTO/SB/08a/b).
- RABBANI et al., J. Biol. Chem. (1984) 259(5):2949-2955 (D28) (previously submitted).
- Decision 06-1087 of the United States Court of Appeals for the Federal Circuit (D29) (previously submitted).

Document number 20 is from the prosecution of Application No. 11/437,428.

Applicants filed the present application to provoke interference with Application No. 09/898,398. Application No. 11/437,428 claims the benefit of 09/898,398. Document number 36 is from the prosecution history of Application No. 10/945,608, which is a Continuation of the present application.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has

been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000624.

Dated: October 19, 2007

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040  
(858) 720-5117